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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/682,445  | 10/09/2003  | Takayoshi Otomo      | TSL - 1714CIPUS     | 9801             |
| 8131  | 7590        | 01/05/2006           |                     |                  |
| MCKELLAR IP LAW, PLLC<br>784 SOUTH POSEYVILLE ROAD<br>MIDLAND, MI 48640 |             |                      | EXAMINER            |                  |
|   |             |                      | ROBERTSON, JEFFREY  |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1712                |                  |

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                      |                  |
|------------------------------|----------------------|------------------|
| <b>Office Action Summary</b> | Application No.      | Applicant(s)     |
|                              | 10/682,445           | OTOMO, TAKAYOSHI |
|                              | Examiner             | Art Unit         |
|                              | Jeffrey B. Robertson | 1712             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 October 2005.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 3-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1 and 3-8 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 10/114,374.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

The examiner notes applicant's attempt to amend the specification. However, the amendment does not appear to comply with 37 CFR § 1.121 (b)(1)(i) and (b)(1)(ii) or (b)(2)(i) and (b)(2)(ii). There is no specific instruction to the place of amendment and there is no marked up copy present. Therefore the above objection is continued.

### ***Claim Objections***

2. Claim 6 is objected to because of the following informalities: Claim 6 is objected to because it depends from a cancelled claim. For examination purposes, claim 6 will be treated as if it depends from claim 1. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (U.S. Patent No. 5,770,298) in view of Ota et al. (U.S. Patent No. 5,950,061).

For claim 1, in column 2, lines 51-67, Nakamura teaches a silicone gel composition containing an alkenyl-substituted organopolysiloxane having at least two alkenyl groups per molecule, an organohydrogenpolysiloxane having at least two silicon-bonded hydrogen atoms per molecule, and a sufficient amount of platinum catalyst to cure the composition. In column 6, line 57 through column 7, line 8, Nakamura discloses that the composition may also contain 5-500 parts of silica filler per 100 parts of the alkenyl-substituted polyorganosiloxane component, which significantly overlaps the range set forth by applicant. For claim 3, in column 3, line 41 through claim 4, line 28, Nakamura sets forth polymers that may be used as the alkenyl-substituted organopolysiloxane, including dimethylsiloxane/methylvinylsiloxane copolymers that are end-blocked with trimethylsiloxy groups. These copolymers correspond to the copolymers set forth in (iii) of claim 3. For claim 4, in column 4, line 59 through column 5, line 25, Nakamura teaches that the organohydrogenpolysiloxanes are dimethylsiloxane-methylhydrogensiloxane copolymers where the chain terminals

are blocked with trimethylsiloxy groups, corresponding to the copolymers set forth in (iii) of claim 4. For claims 1 and 5, in column 5, line 60 through column 6, line 42, Nakamura discloses that a diorganopolysiloxane free of alkenyl and silicon-bonded hydrogen groups is added in an amount of 5-200 parts per weight per 100 parts by weight of the alkenyl-substituted organopolysiloxane. Here, for claim 5, Nakamura teaches that this diorganopolysiloxane is a dimethylpolysiloxane that is endblocked with trimethylsiloxy groups.

Regarding the range limitation for component C of claim 1, it is noted that applicant's claim is directed to ranges of "greater than 200" parts by weight, while Nakamura teaches from 5 to 200 parts by weight. The examiner's position is that one of ordinary skill in the art would not have expected a composition containing 200.0000001 parts by weight of component C to perform differently than a composition containing 200 parts by weight of component C. Although Nakamura teaches that the diorganopolysiloxane *may* bleed when exceeding 200 parts by weight in column 6, lines 40-42, the examiner's position is that bleeding would not necessarily occur. Furthermore, at ranges extremely close to 200 parts by weight as set forth above, such bleeding would not be expected to occur. Therefore it would have been obvious to one of ordinary skill in the art to use amounts that slightly exceed 200 parts by weight depending on the desired durometer and penetration characteristics of the resulting composition. A *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would

have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

For claim 7, in column 6, lines 56-61, Nakamura teaches that the gel is molded.

For claim 6, in Example 4, Nakamura teaches that alkenyl-substituted polyorganosiloxane is mixed with filler thus forming applicant's gel base. To this is added the organohydrogenpolysiloxane, platinum catalyst, and trimethylsiloxy end-blocked dimethylpolysiloxane.

Although Nakamura teaches a low durometer fixing roll, Nakamura fails to teach that the Asker C hardness is from 1 to 30 °.

Ota teaches fixing rollers with a silicone intermediate layer in column 3, lines 35-48, and Figure 3. Ota teaches in column 5, lines 50-55 and column 6, lines 20-27 that the Asker C hardness of the fixing layer be 1-30° to enhance the fixing efficiency of the toner image on paper.

Nakamura and Ota are analogous art in that they both teach fixing rollers containing intermediate layers of silicone. It would have been obvious to one of ordinary skill in the art at the time of the invention to formulate the gel of Nakamura so that the Asker C hardness would be between 1-30°. The motivation would have been that Ota teaches that intermediate silicone layers with this hardness enhance the fixing efficiency of the toner image on the paper. One of ordinary skill in the art, seeking to improve the fixing efficiency would have formulated the gel of Nakamura within the specified hardness range to achieve this improvement.

***Response to Arguments***

5. Applicant's arguments filed 10/24/05 have been fully considered but they are not persuasive.

Applicant argues that Nakamura fails to teach that mould releasability is improved through the addition of component (E) and that Ota fails to teach a silicone gel composition and would not be combinable with Nakamura. The examiner does not find these arguments persuasive.

Regarding applicant's first argument, although Nakamura does not teach that the fillers are added to improve mould releasability, Nakamura does teach that the fillers are added for the purpose of improving the mechanical strength, thermal conductivity and electroconductive properties of the silicone gel. The reason for adding the filler to the composition need not be the same as applicant's motivation. Also, applicant does not set forth that the filler is added to improve mould releasability, but to improve the mechanical strength. See specification paragraph [0023].

Regarding applicant's second argument, the Ota reference is not cited for teaching silicone gels, it is cited for the teaching that intermediate silicone layers in fixing rolls preferably exhibit the claimed hardness to enhance the fixing efficiency of the toner image on the paper. Therefore, applicant's arguments are not persuasive and the rejection as set forth above is continued.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

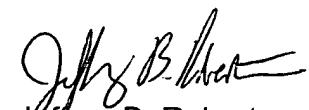
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JBR



Jeffrey B. Robertson  
Primary Examiner  
Art Unit 1712